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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,043	02/19/2002	Vladimir Gartstein	8431M	4983

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THE PROCTER & GAMBLE COMPANY  
INTELLECTUAL PROPERTY DIVISION  
WINTON HILL TECHNICAL CENTER - BOX 161  
6110 CENTER HILL AVENUE  
CINCINNATI, OH 45224

EXAMINER

PEFFLEY, MICHAEL F

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 12/30/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/078,043

Applicant(s)

GARTSTEIN ET AL. *on*

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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Applicant's amendments and arguments, received December 1, 2003, have been fully considered by the examiner. In particular, the amendments have obviated the 35 USC 112, second paragraph rejections. The following is a complete response to the December 1, 2003 communication.

### ***Claim Objections***

Claims 8 and 14 are objected to because of the following informalities: claims 8 and 14 are identical and they recite a controller which is manageable from a location "remote form" which should apparently read "remote from".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Eckhouse ('772).

As asserted in the previous Office action, Eckhouse discloses a device for treating tissue which comprises a broadband electromagnetic source for treating tissue *in vivo*. The device is a flashlamp which provides light having a wavelength in the 300-1000nm range (col. 5, line 25) with pulse durations (col. 7, lines 15-25) and energy intensities (col. 8, lines 30-32) within the ranges disclosed by the applicant. Eckhouse also discloses a controller for controlling the delivery of energy as well as various filter

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means for providing specific wavelengths (col. 5, lines 45+). Also, Eckhouse disclose a controller (i.e. microprocessor) which is manageable from a remote location via a data link connected to a user interface. It is noted that a keyboard or mouse is deemed to be an interface remotely located from the controller (col. 16, lines 16-25) and connected with a data link (i.e. cable). Eckhouse does not specifically disclose the treatment of pathogens, however the examiner maintains that use of the device will inherently perform such a function since the radiation is provided in the exact same wavelength and energy ranges as disclosed in applicant's specification. With specific regard to the apparatus claims, it is noted that the intended use of the apparatus bears little or no patentable weight to the claims, particularly where the structure being set forth is the same as that disclosed in the prior art. Concerning the method claims, the examiner again maintains that use of the device would inherently afford the method steps as the Eckhouse device is used to treat tissue (i.e. human skin) with parameters consistent with those in applicant's disclosure. Any pathogens on the skin tissue would inherently be suppressed in view of the identical operating parameters, regardless of whether or not Eckhouse teach that particular effect.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 10 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckhouse ('772) in view of the teaching of Talmore ('433).

As addressed above, Eckhouse discloses a device which would inherently treat pathogens given that it emits radiation of the same wavelength and energy as applicant's disclosed device. However, in order to more clearly show that the treatment of pathogens with light energy is known, the Talmore device is being referenced.

Talmore discloses a light treatment device for the treatment of psoriasis, similar to the Eckhouse skin treatment device. In particular, Talmore teaches the use of flashlamps to treat psoriasis, as well as additional skin conditions such as skin fungus as disclosed in column 4, lines 62-68 of the Talmore patent. It is noted that one of the pathogen treated conditions disclosed and claimed in the instant application includes skin conditions involving fungi.

Hence, to have utilized the Eckhouse device to treat skin pathogens, in addition to or in lieu of the disclosed use of treating psoriasis, would have been an obvious consideration for one of ordinary skill in the art since Talmore teaches that psoriasis light treatment devices may also be used to treat pathogen related conditions of skin.

### ***Response to Arguments***

Applicant's arguments filed December 1, 2003 have been fully considered but they are not persuasive.

Concerning claim 1, applicant contends that the claim as amended recites that the *in-vivo* location is a plant or parts thereof and Eckhouse therefore does not teach every element of the claim. The examiner's position is that the added limitation is

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merely directed towards the intended use of the device and is no way a structural limitation. Therefore, there is no "element" missing from the Eckhouse reference as Eckhouse teaches every structural element and is simply silent with respect to the use of the device to treat a plant. Applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Similarly, claim 11 recites a device that is "adapted for placement proximate to said tympanic membrane of said animal". Again, this recitation defines no particular structure and is only suggestive of how the device may be used. The examiner maintains that while the Eckhouse reference is silent regarding the treatment of the tympanic membrane of a subject, the device is inherently capable of being located in proximity to the tympanic membrane and therefore meets the structural limitations of the claims.

The amendment to claim 10 to make it depend from claim 11 is deemed to have no effect on the scope of the claim. Claim 11, as discussed above, merely requires the device to be capable of being located in proximity to a tympanic membrane. The Eckhouse device is clearly "adapted" to be located in proximity to a tympanic membrane. The method steps of claim 11 do not recite that the device is actually located near or used to treat a tympanic membrane. As such, Eckhouse is deemed to

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meet the limitations of claim 11 in that in use, the Eckhouse device would inherently treat pathogens located on the skin surface since it is using radiation wavelengths and energies within the ranges disclosed by the applicant as being effective for treating pathogens. Similarly, the Eckhouse device is deemed to inherently treat pathogens and achieve suppression of such since the device uses the exact same wavelength and energy parameters as disclosed by applicant. That Eckhouse does not teach of the suppression of pathogens does not preclude the device's effective treatment of pathogens given its substantially identical operating parameters.

Finally, applicant has suggested that the examiner has not met the three basic criteria for establishing a prima facie case of obviousness. The examiner disagrees with applicant's assertions that the specific wavelength ranges taught by Talmore and Eckhouse teach away from one another. While each may use different wavelengths of light to treat the body, both devices treat a variety of skin conditions through the application of light. That is, both Eckhouse and Talmore teach the use of light to treat skin conditions such as psoriasis and other conditions. It is clear that both the narrow range of wavelengths taught by Talmore and the broad range of wavelengths taught by Eckhouse may be useful in such procedures. Also of note, Eckhouse also teaches that the broad spectrum range of wavelengths may be narrowed with filtering as necessary (see col. 5, lines 45-55). Talmore teaches that numerous skin conditions, including pathogen containing fungi, may be treated with light energy. It is not the examiner's assertion that the Talmore light source should be embodied within the Eckhouse system. Rather, it is the examiner's position that Talmore suggests to one of ordinary

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skill in the art that skin radiation systems may be used in a variety of procedures including the treatment of fungi. Eckhouse discloses an analogous radiant energy device used to treat a variety of skin conditions. The examiner maintains that there is sufficient suggestion in Talmore to one of ordinary skill in the art that the Eckhouse device may be useful to treat additional skin conditions such as those containing pathogens (e.g. fungi). Use of the Eckhouse device in treating pathogen containing skin would inherently yield a suppression of the growth of pathogens in view of the fact that the Eckhouse system uses radiation commensurate with that applied in the applicant's device. In summary, the examiner maintains that all three criteria of establishing a prima facie case of obviousness have been met. Talmore reasonably suggests that radiation devices may be used in numerous treatments including the treatment of skin containing pathogens. Hence, the examiner maintains that one of ordinary skill in the art would surmise from this teaching that the Eckhouse device may also be used to treat pathogen containing skin conditions, particularly since it treats many of the other conditions disclosed by Talmore. There is clearly a reasonable expectation of success since both systems are for treating numerous analogous skin conditions. And finally, there is no hindsight based on applicant's disclosure to arrive at the presented subject matter. Talmore expressly teaches several treatment modalities, including the treatment of pathogen containing skin tissue, through use of a device which irradiates skin. Eckhouse similarly teaches treating a variety of skin conditions. One of ordinary skill in the art would reasonably expect the Eckhouse device to also be effective in



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treating pathogen containing skin tissue since it is used in many other treatment modalities (i.e. psoriasis) just as the Talmore device.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

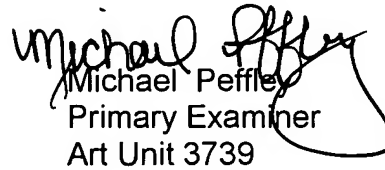
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

  
Michael Peffley  
Primary Examiner  
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December 28, 2003